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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,066	10/05/2005	Benoit Pugin	2005-1466A	6544
513 7590 08/20/2008 WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021			EXAMINER KATAKAM, SUDHAKAR	
			ART UNIT 1621	PAPER NUMBER
			MAIL DATE 08/20/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/552,066

**Applicant(s)**

PUGIN ET AL.

**Examiner**

Sudhakar Katakam

**Art Unit**

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-13 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Status of application*

1. Applicants' response to the restriction requirement filed on 2<sup>nd</sup> May 2008 is acknowledged. However, in view of applicants' election, and upon further consideration, the following new restriction requirement has been applied.

### *Lack of Unity*

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-5, drawn to a compound of formula Ia or Ib, where R<sub>1</sub> and R<sub>2</sub> together is C<sub>4</sub>-C<sub>8</sub>-alkylene. ***This group may be subjected to further restriction based on the R<sub>1</sub>, R<sub>2</sub>, R<sub>3</sub>, R<sub>4</sub>, R<sub>5</sub>, R<sub>6</sub>, X<sub>1</sub> and X<sub>2</sub> groups on the ring/chain of the compound. A single disclosed species, i.e. a single disclosed compound, is hereby requested for search purpose.***


Group II, claims 1-5, drawn to a compound of formula Ia or Ib, where R<sub>1</sub> and R<sub>2</sub> together is 3-oxapentyl-1,5-ene. ***This group may be subjected to further restriction based on the R<sub>1</sub>, R<sub>2</sub>, R<sub>3</sub>, R<sub>4</sub>, R<sub>5</sub>, R<sub>6</sub>, X<sub>1</sub> and X<sub>2</sub> groups on the ring/chain of the compound. A single disclosed species, i.e. a single disclosed compound, is hereby requested for search purpose.***

Group III, claims 1-5, drawn to a compound of formula Ia or Ib, where  $R_1$  and  $R_2$  together is  $-(CH_2)_2-NH-(CH_2)_2-$  or  $-(CH_2)_2-N(C_1-C_4\text{alkyl})-(CH_2)_2-$ . ***This group may be subjected to further restriction based on the  $R_1$ ,  $R_2$ ,  $R_3$ ,  $R_4$ ,  $R_5$ ,  $R_6$ ,  $X_1$  and  $X_2$  groups on the ring/chain of the compound. A single disclosed species, i.e. a single disclosed compound, is hereby requested for search purpose.***


Group IV, claims 1-5, drawn to a compound of formula Ia or Ib, where  $R_2$  and  $R_3$  together is  $C_2-C_8$ -alkylidene,  $C_4-C_8$ -cycloalkylidene,  $C_1-C_4$ -alkylene,  $C_2-C_8$ -alk-1,2-enyl. ***This group may be subjected to further restriction based on the  $R_1$ ,  $R_2$ ,  $R_3$ ,  $R_4$ ,  $R_5$ ,  $R_6$ ,  $X_1$  and  $X_2$  groups on the ring/chain of the compound. A single disclosed species, i.e. a single disclosed compound, is hereby requested for search purpose.***

Group V, claims 1-5, drawn to a compound of formula Ia or Ib, where  $R_2$  and  $R_3$  together is  $-C(O)-$ . ***This group may be subjected to further restriction based on the  $R_1$ ,  $R_2$ ,  $R_3$ ,  $R_4$ ,  $R_5$ ,  $R_6$ ,  $X_1$  and  $X_2$  groups on the ring/chain of the compound. A single disclosed species, i.e. a single disclosed compound, is hereby requested for search purpose.***

Group VI, claims 1-5, drawn to a compound of formula Ia or Ib, where  $R_2$  and  $R_3$

together is . ***This group may be subjected to further restriction based on the  $R_1$ ,  $R_2$ ,  $R_3$ ,  $R_4$ ,  $R_5$ ,  $R_6$ ,  $X_1$  and  $X_2$  groups on the ring/chain of the compound. A single disclosed species, i.e. a single disclosed compound, is hereby requested for search purpose.***

Group VII, claims 1-5, drawn to a compound of formula Ia or Ib, where  $R_1R_2N$  and

$R_3O$  together is . ***This group may be subjected to further restriction based on the  $R_1$ ,  $R_2$ ,  $R_3$ ,  $R_4$ ,  $R_5$ ,  $R_6$ ,  $X_1$  and  $X_2$  groups on the ring/chain of the compound. A single disclosed species, i.e. a single disclosed compound, is hereby requested for search purpose.***

Group VIII, claim 6, drawn to a process for preparing compounds of formula 1a and 1b. ***This group may be subjected to further restriction based on the  $R_1$ ,  $R_2$ ,  $R_3$ ,  $R_4$ ,  $R_5$ ,  $R_6$ ,  $X_1$  and  $X_2$  groups on the ring/chain of the compound. A single disclosed species, i.e. a single disclosed compound, is hereby requested for search purpose.***

Group IX, claim 7, drawn to a compound of the formula VIII in the form of the racemate, a mixture of diastereomers, a pure diastereomer or an enantiomer in optically enriched or optically pure form. ***This group may be subjected to further restriction based on the  $R_1$ ,  $R_2$ ,  $R_3$ ,  $R_4$ ,  $R_5$ ,  $R_6$ ,  $X$  groups on the ring/chain of the compound. A single disclosed species, i.e. a single disclosed compound, is hereby requested for search purpose.***

Group X, claim 8, drawn to a compound of the formula IX (racemate) or a compound of the formula IXa and/or IXb (mixture of diastereomers, a pure diastereomer or an enantiomer in optically pure form). ***This group may be subjected to further restriction based on the  $R_1$ ,  $R_2$ ,  $R_3$ ,  $R_4$ ,  $R_5$ ,  $R_6$ ,  $R_7$ ,  $R^o$  groups on the ring/chain of the compound. A single disclosed species, i.e. a single disclosed compound, is hereby requested for search purpose.***

Group XI, claim(s) 9-11 and 13, drawn to a metal complex. ***A single disclosed species, i.e. a single disclosed compound, is hereby requested for search purpose.***

Group XII, claim 12, drawn to a process to prepare chiral organic compound.

3. The inventions listed as Groups I-XII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: (i) the process for preparing compound of claim 1 can be made using materially different process, (ii) the claims of group I-XII belong to divergent structural compounds. Each of the above groups belongs to a divergent subject matter, and there is no common technical feature to combine the groups, and hence the restriction is proper.

Because these inventions are independent or distinct for the reason given above and there would be a serious burden on the examiner if restriction were not required; because the inventions require a different field of search (see MPEP § 808.02) restriction for examination purposes as indicated is proper.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

4. Upon election of invention of groups I-XII, ***applicant needs to elect a single disclosed species, i.e., single disclosed compound, for examination purposes for either of the group elected.*** Claims will be examined to the extent they read on the

elected species and closely related compounds. Applicant should identify all the claims that are readable on elected species.

5. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

See claims and the examples disclosed in the specification.

Applicant must identify exact and full name of a species for the account of examination purpose and identify the claims readable upon.

***Applicant is required, in reply to this action, to elect a single species to*** which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

6. The following claims are generic:

Claims 1-13 are generic.

7. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: the special technical feature which is referred to Annex B of Appendix A1 of MPEP (Administrative Instructions under the PCT, "Unity of Invention"). Unity exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding claimed technical features. The express "special technical features" is defined as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art ("Rule 13.2).

8. A telephone call was made to Michael Davis on 13<sup>th</sup> Aug 2008 to request an oral election to the above restriction requirement, but did not result in an election being made.

9. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of



record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sudhakar Katakam whose telephone number is 571-272-9929. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Sullivan can be reached on 571-272-0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. K./  
Examiner, Art Unit 1621

/SHAILENDRA - KUMAR/  
Primary Examiner, Art Unit 1621